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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/631,357	07/31/2003	David W. Rockett	GP-303782 2760/116	3461

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General Motors Corporation
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EXAMINER

MANCHO, RONNIE M

ART UNIT	PAPER NUMBER
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3663

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/16/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/631,357

Applicant(s)

ROCKETT ET AL.

Examiner

Ronnie Mancho

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-35 is/are pending in the application.
- 4a) Of the above claim(s) 21-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Newly submitted claims 21-35 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Group I. Claims 17-20 are drawn to a method for automated enrollment and activation of a telematics unit access system, classified in class 701/200

Group II. Claims 21-35 are drawn to a method for processing a vehicle that has recently been sold, classified in class 705/1, 11, 14.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination II has separate utility such as sending vehicle data from a vehicle manufacturing facility to one or more databases, wherein the customer data is sent in response to a recent sale of a vehicle.. See MPEP § 806.05(d).

3. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

The examiner has required restriction between subcombinations usable together. Where applicant elects a subcombination and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable

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subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 21-35 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 17-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claims 17-20, the applicant recites, “a method for automated enrollment and activation of a telematics unit access system”, and “a telematics unit *of the vehicle*”.

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As seen from applicant's specification, and drawings, the applicant instead activates a telematics unit of a vehicle. The applicant did not disclose "activating of a telematics unit access system as claimed. That is applicant disclose fig. 1 to represent a telematics unit access system 100 (applicant's page 4, line 10, etc). System 100 was not disclosed to be enrolled by the applicant. Actually the applicant disclosed how a unit in a car is enrolled through a dealer or master station 170. It really is not clear and possible to enroll system 100 as disclosed by the applicant. This is new matter.

In addition, the applicant amended claim 17 recites, "wherein said sending, enrolling, and activating steps are carried out *AFTER* performing the steps of:

determining that the vehicle associated with the customer data record is powered up; and
determining that the vehicle is sold.". There is no support for the limitations in applicant's disclosure. This is new matter

The rest of the claims are rejected for depending on a rejected base claim.

6. Claims 17-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 17-20 rejected under 35 U.S.C. 101 because the claims do not disclose any tangible result. The applicant's claim 17 calls for enrolling a telematics unit access system. However, the body of the claim does not teach such a limitation.

The rest of the claims are rejected for depending on a rejected base claim.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 17-20 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 17-20, the applicant recites, “a method for automated enrollment and activation of a telematics unit access system”, and “a telematics unit *of the vehicle*”.

As seen from applicant’s specification, and drawings, the applicant instead activates a telematics unit of a vehicle. The applicant did not disclose “activating of a telematics unit access system as claimed. That is applicant disclose fig. 1 to represent a telematics unit access system 100 (applicant’s page 4, line 10, etc). System 100 was not disclosed to be enrolled by the applicant. Actually the applicant disclosed how a unit in a car is enrolled through a dealer or master station 170. It really is not clear and possible to enroll system 100 as disclosed by the applicant. This is new matter.

In claim 17, the applicant further recites, “determining that the vehicle associated with the customer data record is powered up”. It is not clear what all is meant and encompassed by the phrase, “powered up” as disclosed in the claims. That is it is not clear if the claimed “powered up” refers to a vehicle when its ignition switch is turned to a position such that electric power flows and turns on the instruments or if the phrase refers to a vehicle whose engine is running after being turned on. The rejection applies to claim 18.

In claim 19, it is not clear what all is meant and encompassed by the phrase, “performing a preliminary activation of”. Although the phrase is mentioned in the specification, there is no

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express explanation of “performing a preliminary activation” in regard to the metes and bounds of the scope of the claim.

As already pointed out above applicant’s disclosure does not teach enrollment of system 100 (a telematics unit access system). As such a reasonable art rejection cannot be applied to claims that are not comprehensible or taught by the applicant.

Response to Arguments

9. Applicant’s arguments filed 10/23/06 have been fully considered but they are not persuasive.

The applicant argues that the term, “powered up” is well known in the art in such a manner that one skilled in the art will understand that the term implies that “the vehicle is sold”. It is noted that the term “powered up” has no relation whether a vehicle is sold or not. It is further noted that applicant has not admitted that “said sending, enrolling, and activating steps are carried out AFTER performing the steps of determining that the vehicle associated with the customer data record is *POWERED UP*; and determining that the vehicle is sold”.

Applicant further argues about “sold”. Applicant’s explanation and interpretation of the term in the argument is not disclosed in the original invention. One skilled in the art will construe the term in the restrictive sense to mean transfer of title, exchange of cash or other form of payment, etc.

Arguments drawn to the limitation, “determining whether a customer Is in the vehicle with the dealer” are moot since the limitation is no longer in the claims.

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Applicant further argues that the phrase “performing a preliminary activation” is definite. The examiner disagrees. Applicant is required to explicitly disclose the limitations of the invention in the specification. There was no explanation regarding the above term in the original disclosure.

Arguments drawn to the 103 rejections are moot for reasons already cited above.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Communication

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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ronnie Mancho whose telephone number is 571-272-6984. The examiner can normally be reached on Mon-Thurs: 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Keith can be reached on 571-272-6878. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ronnie Mancho
Examiner
Art Unit 3663

1/7/07

JACK KEITH
SUPERVISORY PATENT EXAMINER